

### REMARKS

This Amendment is in response to the Office Action of July 15, 2003, in the above-identified application. At the time of the Office Action, claims 1-13 were pending in the application but the Office Action addressed only claims 1-6, rejecting those claims as patentable under 35 U.S.C. §103(a) over Burnside '281 and Tetzlaff '117 patents. In response to the Office Action, independent claims 1 and 4 have been amended, claims 7, 8, 11 and 12 have been cancelled and new dependent claims 14-20 and independent claim 21 have been added. The title is also amended for consistency.

In response to the Office Action, claim 1 has been substantially amended, deleting certain features and adding others. As now written, claim 1 calls for at least one of the jaws of the claimed clamping and ablating device to include a surface for engaging tissue clamped between the jaws. The surface comprises insulative material, and an aperture extends through the insulative material. The respective conductive member of such jaw is carried in the jaw and conductive of electrical energy through the aperture to tissue clamped between the jaws.

Neither the Burnside nor Tetzlaff patents discloses or suggests a device for clamping and ablating cardiac tissue that includes this combination of features recited in claim 1. More specifically, neither Burnside nor Tetzlaff discloses a device

for clamping and ablating cardiac tissue comprising at least one jaw, the surface of which comprises insulative material, an aperture extending through the insulative material, and the respective conductive member or electrode being carried in the jaw and conductive of electrical energy through the aperture to tissue clamped between the jaws.

For at least the above reasons, it is respectfully submitted that the subject matter claim 1 is not disclosed or suggested in either of the cited references, and that independent claim 1 and dependent claims 2, 3, and 14-19 (which include all the features of claim 1) would not have been obvious to a person of ordinary skill in the field and are allowable.

In addition, independent claim 4 has also been amended to recite among other things, that the electrode of at least one jaw has an inner lumen. As thus amended, claim 4 is directed to a tissue grasping apparatus having first and second grasping jaws that are relatively movable between open and closed position.

Each jaw in claim 4 includes an electrode and a clamping surface in opposed relation with the electrode and clamping surface of the other jaw. The electrode of at least one jaw defines an inner lumen. The clamping surfaces of the jaws comprise an insulating material and the opposed electrodes are connectable to a power source, which is not limited to bipolar or monopolar, for providing an electrical current through tissue clamped between the electrodes. The cited Burnside and Tetzlaff

patents do not disclose or suggest a tissue grasping apparatus having this combination of features, including specifically an electrode of at least one jaw that has an inner lumen.

For at least these reasons, the subject matter of independent claim 4 and dependent claims 5, 6, 9, 10, 13, and 20 (which include all the features of claim 4) is not disclosed or suggested in the cited Burnside and Tetzlaff patents, whether considered separately or together.

Finally, new independent claim 21 has been added. Claim 21 is directed to tissue ablation apparatus including, inter alia, first and second jaws. Each jaw includes a tissue engaging surface, an elongated aperture in the tissue engaging surface and an elongated electrically conductive member carried by the jaw and conductive of electrical energy through the aperture to tissue engaged between the jaws. The elongated conductive member of each jaw defines an inner lumen.

For reasons similar to those discussed above, the Burnside and Tetzlaff patents do not disclose or suggest the subject matter set forth in new claim 21.


#### **INFORMATION DISCLOSURE STATEMENTS**

Applicant requests that references cited in the Third, Fourth and Fifth Supplemental Information Disclosure Statements, mailed July 18, 2003, August 12, 2003 and September 18, 2003, be considered and made of record in the present application.

For all of the above reasons, it is respectfully submitted that the claims of the above-identified application are allowable, and reconsideration is respectfully requested.

Respectfully submitted,

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